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EXAMINER

MICHENER, JENNIFER KOLB

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/054,089

Applicant(s)

STUCKEY, VIRGINIA

Examiner

Jennifer Kolb Michener

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7 and 9-10, drawn to a method of coating, classified in class 427, subclass 4.
 - II. Claims 8 and 11, drawn to coated straw, classified in class 428, subclass 15.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process such as spray-coating.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. This application contains claims directed to the following patentably distinct species of the claimed invention: I) pre-cutting (as outlined in claims 6 and 9) and II) post-cutting (claim 7) the straw.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include confirmation of the identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. During a telephone conversation with Michael McKee on October 6, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-7 and 9-10 and species I, claims 1 and 9, instead of species II, claim 7. Affirmation of this election must be made by applicant in replying to this Office action. Product claims 8 and 11, along with non-elected pre-cutting species claim 7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Byrd (5,389,116).

Byrd teaches a method for coloring mulch, for use in ground cover, said mulch comprising small pieces of straw (abstract; col. 2, line 48; col. 3, lines 15-17 and 36; col.

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5, lines 29-31 and 37). Byrd inherently provides an amount of straw and an amount of coloring agent. Byrd teaches the use of "coloring dyes" as the coloring agent.

Examiner notes that "dye" is defined as to color with a dye, especially by soaking in a coloring solution. Therefore, the dye of Byrd is a liquid, as required by Applicant. Byrd teaches mixing of the straw mulch with a dye added, following by drying.

Regarding claim 2, the dye of Byrd is inherently used to impart its color.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 4, 5, 6, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrd.

Regarding claims 5 and relevant portions of claim 9, Byrd teaches mulch straw pieces ranging in size from 0.06-3 inches, overlapping the range claimed by Applicant of less than 2 inches.

Overlapping ranges are *prima facie* evidence of obviousness. It would have been obvious to one having ordinary skill in the art to have selected the portion of Byrd range that corresponds to the claimed range. *In re Malagari*, 184 USPQ 549 (CCPA 1974).

Regarding claim 4, while Byrd does not teach the use of "food coloring" as the dye or coloring agent, it is noted that dye is inclusive of food coloring. It is Examiner's position that it would have been obvious to one of ordinary skill in the art to select food coloring, a tasteless, odorless coloring agent safe for consumption, from among the broad class of dyes with the expectation of successful results. Because ground covering must be safe for animals, insects, and children at play, with negligible environmental impact, the selection of "food coloring" from the broad class of "dye" for organic materials would have been an obvious choice to one of ordinary skill in the art.

Regarding the limitations of claims 9 and 10 not already addressed, above, to "dye" is defined as soaking in a dye solution, which is inclusive of "submerging".

13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrd in view of USDA reference.

Byrd teaches that which is disclosed above, namely coloring mulch straw for use as ground cover, but fails to teach which color should be used. It is Examiner's position that the use of a green color would have been obvious to one of ordinary skill in the art desiring to match the mulch to a grassy surrounding and Examiner cites "Lawns and Gardens", an article by the USDA Forest Service, to teach the same.

This article teaches the use of chopped straw fiber, dyed green for aesthetic application to the ground for lawns and grasses.

Since Byrd teaches coloring chopped straw and the USDA article teaches dyeing chopped straw green for aesthetic application to grasses, the USDA article would have reasonably suggested a green color for use in the dyeing method of Byrd. It would have been obvious to one of ordinary skill in the art to use the teachings of the USDA in the method of Byrd to provide a suitable coloring for use on ground-cover mulch.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. A USDA article entitled "Beautifying America with Cotton-Waste Mulch" teaches a hydromulch mixture containing a straw slurry with water and green dye.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kolb Michener whose telephone number

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through December is 703-306-5462 (after January 1, 2004: 571-272-1424). The examiner can normally be reached on Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on 703-308-2333. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read "Jl Kolb Michener".

Jennifer Kolb Michener
Patent Examiner
Technology Center 1700
October 17, 2003